

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Ted A. BARNES

Serial Number: 10,727,697

Filed: December 4, 2003

For: ACCESSORY MOUNT FOR VEHICLE
CONTROL BODIES

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§

Group Art Unit: 3727

Examiner: Lester L. Vanterpool

DECLARATION OF TED BARNES UNDER 37 C.F.R. §1.132

Dear Sir:

I, TED BARNES, being duly sworn, depose and say:

1. I am over the age of 18 and am otherwise competent to make this declaration. I have personal knowledge of the matters stated herein, and I believe the matters stated herein are true and correct.
2. I am the President and CEO of PenGraphx, Inc. d/b/a Dallas Motorcycle Accessories ("DMA"), whose address is as follows:

Dallas Motorcycle Accessories
3352 Broadway Blvd. PMB 434
Garland, Texas 75043
3. I am the sole inventor of the invention which is the subject of the U.S. Patent Application Serial Number 10,727,697.
4. The closest subject matter that exist in the prior art to the pending application is generally represented by U.S. Patent 6,588,637 to Gates, and specifically by commercially available products known as "U-bolt base with a ball mount" in which, like gates, the U-

bolt is attachable handlebars. Attached as Exhibit A is screen print of a commercially available U-bolt base having a ball mount (<http://65.102.174.116/rammount/productdetail.aspx?partnumber=RAM-B-231&searchTerm=RAM-B-231&item=1>).

5. Prior to my invention, the U-bolt base could be attached to an exposed portion of the handlebars. The U-bolt bracket, or base, would have an arm portion for direct attachment to the accessory, or to a special sleeve designed to hold the accessory. Alternatively, and closest to the present invention, that U-bolt bracket would have a ball stud attached, or attachable thereto. This information is disclosed in paragraphs [006] and [007] of my application.
6. As of this date, the U-bolt base with ball stud attachment, such as in U.S. Patent 6,588,637 to Gates, is the only commercially practical alternative to my invention.
7. In 2002, I began manufacturing and selling the Gadget Mount™ accessory mounting device for handle-barred vehicles in accordance with the exact teachings of the subject patent application.
8. National Products, Inc. d/b/a RAM Mount Systems ("NPI") has been in business for over ten years and has obtained patent protection for its various designs related to accessory mounting for motorcycles. They are one of the largest U.S. retail providers of accessory mounts for motorcycles.
9. For several years, NPI has been a primary commercial supplier of accessory mounting systems for handle bars in accordance with the prior art under product numbers RAM-B-231, and RAM-B-231-1U. See Exhibit A.
10. On December 2, 2002 (seven days prior to my filing of provisional application from which the above-referenced Application claims priority), Jeff Carnevali of NPI attempted

to obtain one of the vehicle accessory mounts described and claimed in the above-referenced Application and other related pending applications from a DMA customer. The customer refused to provide the device. Attached as Sealed Exhibit B is a copy of the correspondence between our customer and NPI. Please note that the correspondence from our customer contains proprietary information, which has been submitted in accordance with MPEP §724.02.

11. On August 23, 2003, Jeff Carnevali of NPI contacted DMA to obtain the right to manufacture and sell vehicle accessory mounts described and claimed in the above-referenced Application and other related pending applications. DMA declined, as DMA did not desire to utilize NPI at that time. Attached as Exhibit C is a copy of the relevant correspondence between DMA and NPI.
12. Immediately thereafter, NPI began manufacturing and selling accessory mounts for attachment to vehicle control bodies in accordance with the exact teachings and claims of my pending application. Attached as Exhibits D and E are printouts of the webpages http://www.ram-mount.com/index_files/radar2a.jpg and http://www.ram-mount.com/index_files/radar3a.jpg, respectively, of NPI which offers for sale "Handlebar Assembly mount for clutch/brake reservoir" products RAM-B-309-2 and RAM-B-309-1. These products are copies of the Gadget Mount™ and are made in accordance with the exact teachings of the subject patent application.
13. The NPI website has many pages of content. The "Handlebar Assembly mount for clutch/brake reservoir" (RAM-B-309-2 and RAM-B-309-1) is illustrated on the same page (http://www.ram-mount.com/mount/radar_detector_mount.htm), which is attached as Exhibit F, and immediately below the prior art device "U-bolt base" (product numbers RAM-B-231, and RAM-B-231-1U). As can be determined from this website, the device which is a direct copy of my invention sells for approximately \$10.00 more than the prior art device.

14. On April 24, 2004, a letter was sent from DMA's counsel to NPI to inform NPI that their products RAM-B-309-2 and RAM-B-309-1 may potentially infringe the above-referenced Application and other related pending applications. Attached as Exhibit G is a copy of the letter.
15. On July 21, 2004, a letter was sent from DMA's counsel to NPI to inform NPI of DMA's provisional rights with respect to the above-reference Application and other related pending applications. Attached as Exhibit H is a copy of the letter.
16. As of the date of this Declaration, NPI continues to manufacture and sell a copy of the Gadget Mount™. The Gadget Mount™ is an exact replica of the vehicle accessory mount described and claimed in the above-referenced Application. Again, attached as Exhibits D through F are screen shots of the websites offering the sale of NPI's products RAM-B-309-2 and RAM-B-309-1. Also, Exhibits F and A are screen shots of the aforementioned prior art assembly mounts (product numbers RAM-B-231, and RAM-B-231-1U) offered for sale on the same website.
17. Since its introduction, the Gadget Mount has enjoyed substantial commercial success and unexpected demand. The Gadget Mount has always been, and still is, the number one selling product sold by DMA.
18. Prior to NPI's promotion and sale of copies of the Gadget Mount, DMA was selling as many as 500 units per month.

19. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like are punishable by fine and imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the subject Application or any patent issuing thereon.

A handwritten signature in black ink, appearing to read "Ted Barnes", written over a horizontal line.

Ted Barnes



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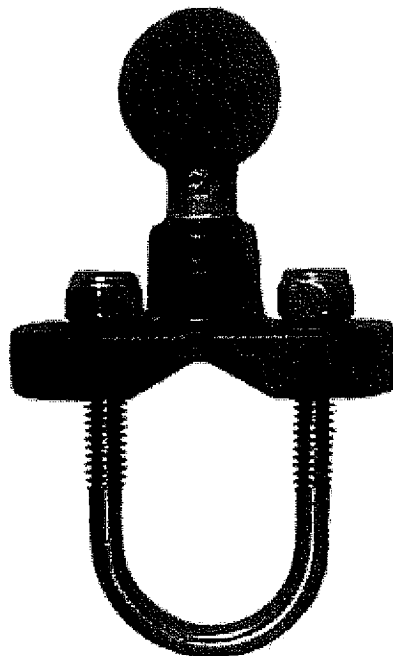
RAM Catalog
PDF Format: [Click Here](#)

RAM Mount Search



RAM-B-231

RAM BASE W/ U-BOLT FOR 3/4" TO 1" DIA.



[DETAILS](#) [REVIEWS](#) [FAQ](#) [COMPARE](#) [LINKS](#) [QUALIFICATIONS](#)

PRODUCT DESCRIPTION

Part number reflects product packaged in clear clam shell for store shelf display.

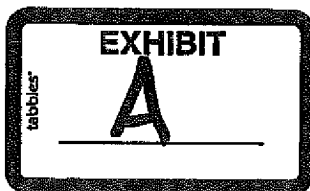
FEATURES

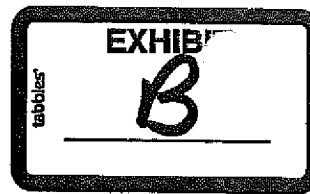
MATERIAL: Powder Coated Marine Grade Aluminum
BALL SIZE: 1 Inch Rubber Ball
COLOR: Black Powder Coat
WEIGHT: 0.28 lbs

PRICES

RETAIL: \$19.10

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John Patti

From: John Fischer
Sent: Monday, March 27, 2006 3:51 PM
To: John Patti
Subject: FW: Jeff from RAM

John G. Fischer
Storm LLP
901 Main Street Ste. 7100
Dallas, Texas 75202

214.347.4703
214.347.4799 fax

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From: Ted Barnes [mailto:ta_barnes@comcast.net]
Sent: Sunday, November 09, 2003 4:19 PM
To: John Fischer
Subject: FW: Jeff from RAM

-----Original Message-----

From: JOLawson [mailto:jolawson@comcast.net]
Sent: Sunday, November 09, 2003 10:46 AM
To: ta_barnes@comcast.net
Subject: Fw: Jeff from RAM

----- Original Message -----

From: Laurene Franklin
To: JOLawson
Sent: Monday, December 02, 2002 4:33 PM
Subject: Jeff from RAM

I got a phone message from Jeff that he left on Friday....he told me to "send him one of those Ezy Gadget Mounts...he wanted to tool up to make them and he could make them for a lot less. ????

I personally think he is a little arrogant and would rather have him have asked to discuss the matter rather than just being commanded to send him one....it also bothered me that he approached us....he knows we don't make it and that Dallas Motorcycles does...after all you buy OEM parts from him...

I think I told you that he forwards emails to us all the time without ever responding to the person (sometimes 4-6 a day) the emails are all questions about which RAM part to buy for the persons motorcycle.... I think what is happening is that he is getting enough emails that are asking where to get the Ezy Gadget mount....to actually notice that there may be a market he isn't covering....

3/28/2006

Before I respond to him, I wanted to let you know his question. You might be interested in having RAM make these for you...but knowing Jeff he would want it to be a RAM part...if that was the case you would want to ask for MUCHO \$ for the rights to the part AND if it isn't patented GET ON IT NOW.
Let me know your thoughts.

Laurene Franklin
CycleGadgets.com Customer Service
Toll Free 877-7GADGET (877-742-3438)

Proprietary

John Patti

From: John Fischer
Sent: Monday, March 27, 2006 3:49 PM
To: John Patti
Subject: FW: RAM Mount Proposal



John G. Fischer
Storm LLP
901 Main Street Ste. 7100
Dallas, Texas 75202

214.347.4703
214.347.4799 fax

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-----Original Message-----

From: Ted Barnes [mailto:tabarnes@dallasmotorcycles.com]
Sent: Wednesday, November 05, 2003 6:02 PM
To: John Fischer
Subject: FW: RAM Mount Proposal

My response to his offer.

-----Original Message-----

From: Ted Barnes [mailto:ta_barnes@comcast.net]
Sent: Saturday, August 23, 2003 8:27 AM
To: 'Jeff Carnevali'; lily@pengraphx.com; jolawson@attbi.com; tabarnes@attbi.com
Subject: RE: RAM Mount Proposal

As you know, we evaluate every product we sell before we offer it to our customers. We would be pleased to accept a set of test units to mount and evaluate in various accessory configurations.

I must reserve any decision about taking on the devices until I have had a chance to discuss this with the company stakeholders.

Several questions arise however: 1) How are you intending to package the units shown? 2) What hardware, if any do you supply with the units? 3) What are the units made of and how (cast aluminum, plastic, etc.)??

I asked the packaging question because of the last shipment of components (Camera bases and double ended balls). They were packed in clamshell packages that are far too big and waste a lot of space in the box and in my storage area. If we ever get this Rally business going the way we want to the packaging will need to be sized to the units.

Actually we would prefer to package the units ourself.

We are going to Springfield, Missouri, for a Drill Team Competition and Trike Show event Labor Day weekend, I doubt we will have time to do much more than prepare for that for the next few days.

Ted Barnes

-----Original Message-----

From: Jeff Carnevali [mailto:jeffc@ram-mount.com]

Sent: Saturday, August 23, 2003 2:13 AM

To: lily@pengraphx.com; jolawson@attbi.com; tabarnes@attbi.com

Subject: RAM Mount Proposal

Importance: High

Hello Dallas Motorcycle Gang,

Since RAM has been involved in the motorcycle industry we have seen many additions and adaptations to our basic systems and components. The one I would like to speak to you about is the method that you have utilized the ball on the handlebars of motorcycles. We had developed a Universal Screw On/ U-Bolt Style base with ball plus many other types of bases with balls to attach to both handlebars, surfaces, gas caps, etc.. I think you must have seen some of them it at some time because the style of your device looks and functions very similar to a couple of ours. I have attached a few pictures to reference what I'm talking about. Yours differs because a person can move the detachable ball from one placement on the base to another or add up to 2 balls on the same base where the RAM ball base is all one piece and isn't removable.

At one time I offered to manufacture a base with ball for you that you could add to your product line and you refused my offer. Attached are a couple of bases with attached balls that we will be producing that once again I would like to offer to you. They will have OEM cost to your company of less than \$3.75 for the single ball base and less than \$5.25 for the double bass base. This is a lower price than we sell the single ball to you that you currently purchase to screw onto your machined part. It will allow you to pass the savings on to your dealers and also provide a larger market because they are more cost effective for the average biker. You could still provide the higher quality and more of the finished looking product that you already manufacture but this would allow you to offer a broader product line.

I'm making this special offer to you because of the investment that you have

made with us over the past year or so. If you would like to get involved with this offer I would very much like to speak with you in the near future before we start our marketing with these 2 new bases.

Best Regards,
Jeff Carnevali
Pres./CEO

Our company information is as follows:

National Products Inc.

1205 S. Orr St.

Seattle, WA 98108 USA

Phone: 206-763-8361

Fax: 206-763-9615

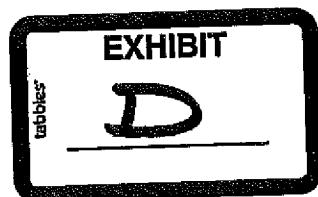
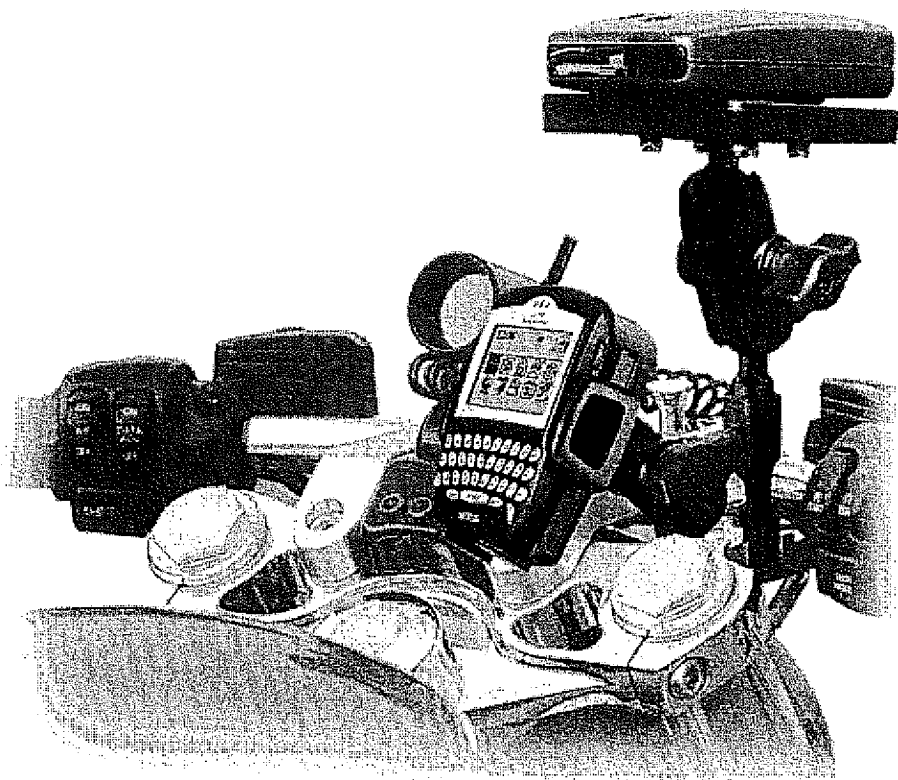
Cellular Phone: (206) 356-2365

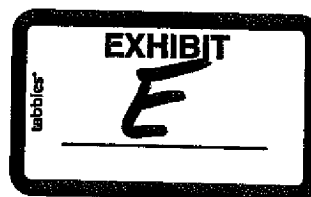
e-mail: <mailto:staff@ram-mount.com>

web: www.ram-mount.com

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RAM Mount Product

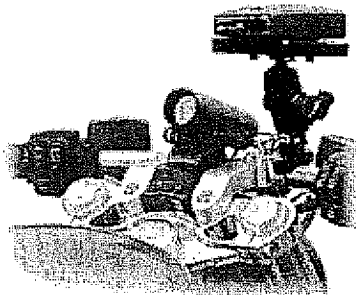
RAM RADAR DETECTOR MOUNTS FOR VEHICLES AND MOTORCYCLES

Patented & Pats. Pend.

With mounts available that are perfect for cars, trucks and motorcycles, RAM is your best choice for radar detectors. Able to connect to any brand of detector in seconds, RAM can get your detector exactly where you want it so it's easy to see and use. Order a complete kit and an extra base of your choosing and transfer the detector with ease to another location. Simple design that will not block or interfere with any function of the detector.

RAM-B-149Z-A-300-1

ENLARGE



Installation Instructions

RAM motorcycle handlebar rail mount. Installation requires two mounting bases, an arm and RAM Power Plate III. Choose the length of arm and base style that fits your needs. Always ensure that electronic devices used on your vehicle are securely restrained or tethered.

Mount Requirements

- (1) Plate [RAP-300-1](#)
- (1) Arm [RAM-B-201-A](#)
- (1) Base [RAM-B-202](#)
- (1) Base [RAM-B-231Z](#)

[Order](#)

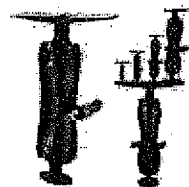
Other Radar Mounts



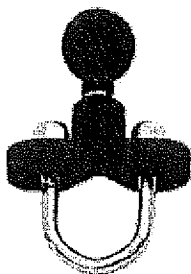
Handlebar Rail

Brake/Clutch
Reservoir
With U-BoltBrake/Clutch
ReservoirSnap Link
Flex BaseRubber Coated
Weighted BaseTwist Lock
Flex Arm

NEW RAM PRODUCTS! 2006 ⇨



Base Components

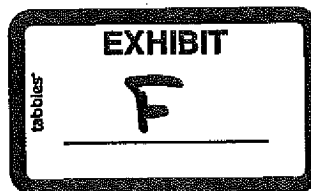

 RAM-B-231
 IN USE PICTURE

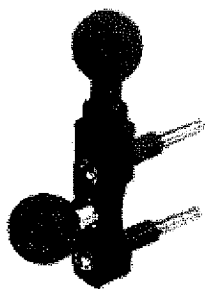

RAM-B-231-1U



RAP-319

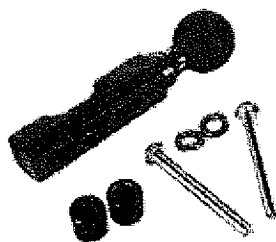
Zinc U-bolt base for 3/4" to 1" handlebars. Stainless Steel U-bolt base for up to 1 1/4" handlebars. U-bolt base with shim for 1/2" to 3/4" handlebars.





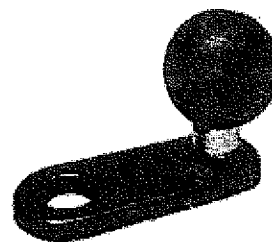
Handlebar Assembly mount for clutch/brake reservoir on Gold Wing and many other bikes. Configured with 2 R-A-M balls for use with 2 arms and devices. Available in Black or Chrome (CH).

RAM-B-309-2



Handlebar Assembly mount for clutch/brake reservoir on Gold Wing and many other bikes. One R-A-M ball cast in place, 2nd ball available. Available in Black or Chrome (CH).

RAM-B-309-1



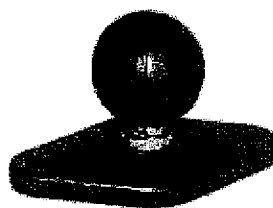
Exclusive BMW Handlebar Bolt Base fits any R1100RT/R1150RT and pre-1997 R1100R.

RAM-B-252U
IN USE PICTURE



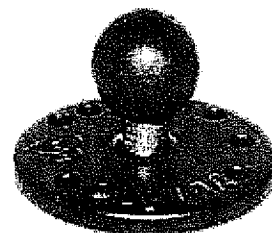
9mm mounting hole w/ offset angle ball, good for mounting under a variety of existing bolts on many bikes

RAM-B-272U



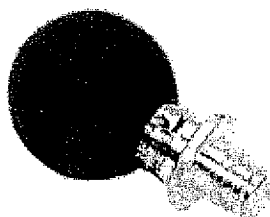
2-7/16" x 1-5/16" diamond-shaped with two mounting holes. Available in Black or Chrome (CH).

RAM-B-238



2-1/2" Round base with 7 holes for a variety of mounting options

RAM-B-202
IN USE PICTURE



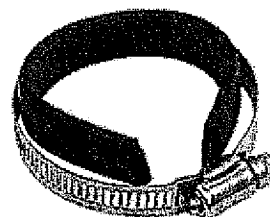
3/8" x 16 threaded post

RAM-B-236U



1/4" x 20 threaded post

RAM-B-237



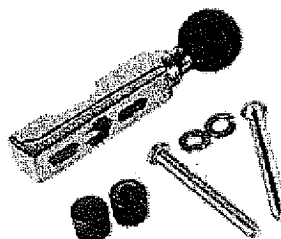
Straps fits 1/2" to 2-1/2" diameter

RAM-STRAP40



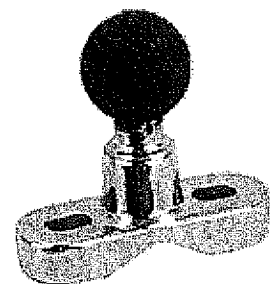
V-base with Straps fits 1/2" to 2-1/2" diameter

RAM-B-108BU



Handlebar Assembly mount for clutch/brake reservoir on Gold Wing and many other bikes. One R-A-M ball cast in place, 2nd ball available. Available in Black or Chrome (CH).

RAM-B-309-1CHU



U-bolt base for 3/4" to 1" handlebars. Available in Black, Zinc or Chrome (CH)

RAM-B-231CHU

Arm Components

You may choose from one of three different lengths of arms in our R-A-M kits, giving you the flexibility of creating a custom solution for your mounting requirements.



Long Arm (5-1/4") (Black only)

RAM-B-201-C



Standard Arm (3") (Black or Chrome)

RAM-B-201



Short Arm (1-3/4") (Black or Chrome)

RAM-B-201-A

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STORM & HEMINGWAY

A LIMITED LIABILITY PARTNERSHIP

PAUL V. STORM
D. SCOTT HEMINGWAY

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DALLAS, TEXAS 75225

OF COUNSEL
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INTELLECTUAL PROPERTY LAW

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WRITER'S DIRECT PHONE
(214) 292-8309
FACSIMILE (214) 292-8999
MARKPERDUE@ALLIPLAW.COM

April 27, 2004

Jeff Carnevali
President and CEO
National Products Inc.
1205 S. Orr St.
Seattle, WA 98108, USA

*VIA FAX (206) 763-9615
and First Class Mail*

RE: "Ram Mount"

Dear Mr. Carnevali:

This firm represents Pen Graphx Inc., a Texas Corporation doing business as Dallas Motorcycle Accessories (DMA). It has come to DMA's attention that you currently are manufacturing and selling a handlebar mounting assembly for motorcycle accessories (commonly referred to as a "gadget mount," and apparently your part number RAM-B-309-2).

You should be aware that DMA has multiple United States Patent Applications pending for the "gadget mount" and that your sale, offer for sale, and manufacture of such devices may constitute patent infringement under Title 35, United States Code.

Upon issuance of these patents, DMA will consider the continued sale, offer for sale, and manufacture of such devices to be acts of willful infringement of the patents.

As a patent holder yourself, we know that you expect others to respect your rights to your intellectual property. We are confident that you will extend that same respect to our client's intellectual property. Thank you for your attention in this matter.

Sincerely,


John G. Fischer

JGF/slf



STORM & HEMINGWAY

A LIMITED LIABILITY PARTNERSHIP

PAUL V. STORM
D. SCOTT HEMINGWAY

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JOHN.FISCHER@ALLIPLAW.COM

July 21, 2004

Jeff Carnevali
President and CEO
National Products Inc.
1205 S. Orr St.
Seattle, WA 98108, USA

VIA Certified Mail

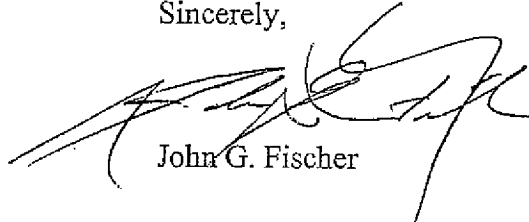
RE: "Ram Mount"

Dear Mr. Carnevali:

As you are aware, this firm represents Pen Graphx, Inc., a Texas Corporation doing business as Dallas Motorcycle Accessories (DMA). For the purpose of providing you with actual notice of my client's provisional rights under 35 USC §155(d), attached is a copy of published U.S. patent application US-2004-0108348-A1. The application was published June 10, 2004, pursuant to 35 USC 122(b), §37 CFR §1.211. The application is entitled Accessory Mount for Vehicle Control Bodies. Additional patent(s) are pending as well, which have not yet been published.

This letter is sent to you as a follow-up of our correspondence dated April 27, 2004, for which a copy is also attached for your convenience.

Sincerely,



John G. Fischer

JGF/slf
Encl.

